

TTAB



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Our File Number: 038T-075078

January 18, 2007

VIA EXPRESS MAIL LABEL EQ432027252US

BOX TTAB-FEE
Commissioner For Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451


Re: Filing of Notice of Opposition for the Mark
DAVINCI DIAGNOSTIC IMAGING & Design
Serial No.: 78/728,786
Filing Date: October 7, 2005
Publication Date: December 19, 2006
On Behalf Of: DaVinci Radiology Associates, L.P.
Our Ref. No.: 038T-075078

Dear Sir:

Enclosed for filing with the United States Patent and Trademark Office is a Notice of Opposition with Exhibits A and B for the trademark DAVINCI DIAGNOSTIC IMAGING & Design, filed October 7, 2005, in the name of DaVinci Radiology Associates, L.P..

Please charge the filing fees of \$300.00 for the submission of the Notice of Opposition as well as any additional fees or charges to our deposit account number **501395**, citing reference number 038T-075078.

Very truly yours,


Michelle D. Kahn

for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

W02-WEST:FKM\400161759.1



01-18-2007
U.S. Patent & TMO/TM Mail Rcpt Dt #72

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,

Opposer,

v.

DAVINCI RADIOLOGY
ASSOCIATES, P.L.,

Applicant.

)
)
) Opposition No. _____
)

) Serial No.: 78/728,786
)

) Filed: October 7, 2005
)

) Published: December 19, 2006
)

) Trademark: DAVINCI DIAGNOSTIC
) IMAGING & Design
)

BOX TTAB-FEE

Commissioner For Trademarks

United States Patent and Trademark Office

P.O. Box 1451

Alexandria, VA 22313-1451

01/22/2007 SMILSON1 00000021 501395 78728786

01 FC:6402 300.00 DA

NOTICE OF OPPOSITION

Intuitive Surgical, Inc. ("Intuitive Surgical") believes that it will be damaged by the registration of the mark DAVINCI DIAGNOSTIC IMAGING & Design, which is the subject of Application Serial No. 78/728,786, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063, and Trademark Rule 2.101, 37 C.F.R. § 2.101.

Application Serial No. 78/728,786 for the mark DAVINCI DIAGNOSTIC IMAGING & Design was filed in the name of DaVinci Radiology Associates, P.L. on October 7, 2005 and was published for opposition in the *Official Gazette* on December 19, 2006, with the description of services for the application reading "medical diagnostic imaging services" ("the Application").

As grounds for the opposition, Opposer alleges that:

1. Opposer Intuitive Surgical is a Delaware corporation having its principal place of business at 1266 Kifer Road, Building 101, Sunnyvale, California 94086-5304.

2. Intuitive Surgical manufactures and sells, in interstate commerce, computerized surgical manipulation systems and associated parts under the mark DA VINCI. Intuitive Surgical has continuously offered and sold computerized surgical manipulation systems and associated parts under the DA VINCI mark since at least as early as July 7, 2000.

3. Intuitive Surgical is the owner of record of Registration No. 2,628,871, Application Serial No. 75/982,190, filed on March 19, 1999, for DA VINCI for use in connection with "computerized surgical manipulation system comprised of surgeon's console, master control, immersive video display, camera image processing equipment, surgical manipulation system software and instructional manuals provided as a unit, patient-side cart with set-up arms and manipulator slave arms, sterile adaptors to connect arms to instruments, and a full line of resposable, in other words, limited re-use tools, namely, laparoscopes, endoscopes, trocars, cannulas, cutters, clamps, elevators, gouges, knives, scope preheaters, light sources, cables and component parts, electrosurgical instruments, electrocautery instruments, laser instruments, ultrasound instruments, lens cleaning, scrub and biopsy brushes, clip applicators and clips, tack applicators and tacks, applicators, ligature carriers, needle holders, clamps, hemostats, graspers, curettes, instrument guides, ligature passing and knotting instruments, needles, retractors, snares, stylets, forceps, dissectors, calipers, scissors, suction and irrigation probes, sterile drapes, hemostats, amputation hooks, osteotomes, saws, retainers, suturing apparatus, measuring tapes, chisels and contractors, files, skin graft expanders, lancets, mallets, pliers, hammers, rasps, spatulas, and strippers; a full line of FDA Classes I and II exempt surgical instruments, namely, scalpels, scalpel blades and handles, staplers, tackers, clip applicators, electrocautery tools, forceps, needle holders, guides and drivers, graspers, and

kiteners" in International Class 10. A copy of the aforementioned registration is appended to this Notice of Opposition as Exhibit A. The foregoing registration is currently valid and subsisting. Intuitive Surgical has continuously offered and sold computerized surgical manipulation systems and associated parts under the DA VINCI mark since at least as early as July 7, 2000.

4. Intuitive Surgical is also the owner of record of Application Serial No. 76/665,748 filed on September 8, 2006, for DA VINCI S HD SURGICAL SYSTEM (Stylized) for use in connection with "computerized surgical manipulation system comprised of surgeon's console, master control, immersive video display, camera image processing equipment, surgical manipulation system software and instructional manuals provided as a unit, patient-side cart with set-up arms and manipulator slave arms, sterile adaptors to connect arms to instruments, and a full line of resposable, in other words, limited re-use tools, namely, laparoscopes, endoscopes, trocars, cannulas, cutters, clamps, elevators, gouges, knives, scope preheaters, light sources, cables and component parts, electrosurgical instruments, electrocautery instruments, laser instruments, ultrasound instruments, lens cleaning, scrub and biopsy brushes, clip applicators and clips, tack applicators and tacks, applicators, ligature carriers, needle holders, clamps, hemostats, graspers, curettes, instrument guides, ligature passing and knotting instruments, needles, retractors, snares, stylets, forceps, dissectors, calipers, scissors, suction and irrigation probes, sterile drapes, hemostats, amputation hooks, osteotomes, saws, retainers, suturing apparatus, measuring tapes, chisels and contractors, files, skin graft expanders, lancets, mallets, pliers, hammers, rasps, spatulas, and strippers, surgical instruments, namely, scalpels, scalpel blades and handles, staplers, tackers, clip applicators, eletrocautery tools, forceps, needle holders, guides and drivers, graspers, and kiteners" in International Class 10. A copy of the Official Filing Receipt for the application is appended to this Notice of Opposition as Exhibit B.

5. Intuitive Surgical has invested millions of dollars in the advertising and promotion of its trademarks DA VINCI and DA VINCI S HD SURGICAL SYSTEM

(Stylized) (the "DA VINCI Marks") for its computerized surgical manipulation systems and associated parts and, upon information and belief, the DA VINCI Marks have become well-known and recognized as Intuitive Surgical's marks among consumers in the relevant industry.

6. As a result of Intuitive Surgical's extensive investment and effort in promoting the DA VINCI Marks for its computerized surgical manipulation systems and associated parts, the DA VINCI Marks have, upon information and belief, come to be recognized by consumers as well-known marks uniquely associated with and belonging to Intuitive Surgical.

7. Upon information and belief, DaVinci Radiology Associates. P.L. is a Florida limited liability company with its principal place of business at 505 South Flagler Drive, Suite 1330, West Palm Beach, Florida 33401. Applicant DaVinci Radiology Associates. P.L. is the current owner of record of Application Serial No. 78/728,786.

8. Applicant seeks registration for the designation DAVINCI DIAGNOSTIC IMAGING & Design allegedly to be used for "medical diagnostic imaging services" under the Application.

9. Applicant's proposed mark DAVINCI DIAGNOSTIC IMAGING & Design is confusingly similar to Intuitive Surgical's previously used and registered DA VINCI Marks and, when used in connection with the purported medical diagnostic services, is likely to cause confusion or mistake or to deceive.

10. Intuitive Surgical is not connected in any way with Applicant or the proposed use by Applicant of the DAVINCI DIAGNOSTIC IMAGING & Design mark for medical diagnostic services as set forth in the Application.

11. Intuitive Surgical's DA VINCI Marks are of sufficient fame and have a sufficient reputation among consumers such that, if and when the mark set forth in the Application is used for medical diagnostic services, a connection with Intuitive Surgical will be presumed by consumers.

12. Upon information and belief, Applicant's proposed use of DAVINCI DIAGNOSTIC IMAGING & Design will disparage Intuitive Surgical, falsely suggest a connection with Intuitive Surgical, or bring Intuitive Surgical into disrepute.

13. The registration of Applicant's alleged DAVINCI DIAGNOSTIC IMAGING & Design mark on the Principal Register would be inconsistent with Intuitive Surgical's rights under the aforementioned registration and common law, and would be damaging to Intuitive Surgical.

WHEREFORE, Intuitive Surgical requests that Application Serial No. 78/728,786 be rejected, that no registration be issued in connection with the Application and that the Board rule in favor of Opposer in this Opposition Proceeding.

Dated: January 18, 2007

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By



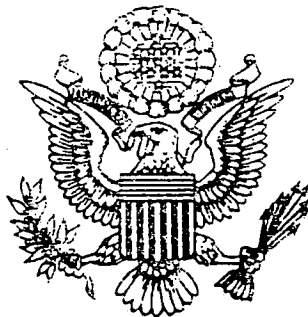
Michelle D. Kahn
Attorneys for Opposer

INTUITIVE SURGICAL CORPORATION

Four Embarcadero Center
17th Floor
San Francisco, CA 94111
TEL: (415) 434-9100
FAX: (415) 434-3947

EXHIBIT A

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Director of the United States Patent and Trademark Office

Requirements for Maintaining a Federal Trademark Registration

SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058, upon the expiration of the following time periods:

- i) At the end of 6 years following the date of registration.
- ii) At the end of each successive 10-year period following the date of registration.

Failure to file a proper Section 8 Affidavit at the appropriate time will result in the cancellation of the registration.

SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. §1059, at the end of each successive 10-year period following the date of registration.

Failure to file a proper Application for Renewal at the appropriate time will result in the expiration of the registration.

No further notice or reminder of these requirements will be sent to the Registrant by the Patent and Trademark Office. It is recommended that the Registrant contact the Patent and Trademark Office approximately one year before the expiration of the time periods shown above to determine the requirements and fees for the filings required to maintain the registration.

Int. Cl.: 10

Prior U.S. Cls.: 26, 39, and 44

Reg. No. 2,628,871

United States Patent and Trademark Office

Registered Oct. 1, 2002

**TRADEMARK
PRINCIPAL REGISTER**

DA VINCI

INTUITIVE SURGICAL, INC. (DELAWARE CORPORATION)
1340 WEST MIDDLEFIELD ROAD
MOUNTAIN VIEW, CA 94043

FOR: COMPUTERIZED SURGICAL MANIPULATION SYSTEM COMPRISED OF SURGEON'S CONSOLE, MASTER CONTROL, IMMERSIVE VIDEO DISPLAY, CAMERA IMAGE PROCESSING EQUIPMENT, SURGICAL MANIPULATION SYSTEM SOFTWARE AND INSTRUCTIONAL MANUALS PROVIDED AS A UNIT, PATIENT-SIDE CART WITH SET-UP ARMS AND MANIPULATOR SLAVE ARMS, STERILE ADAPTORS TO CONNECT ARMS TO INSTRUMENTS, AND A FULL LINE OF RESPONSABLE, IN OTHER WORDS, LIMITED RE-USE TOOLS, NAMELY, LAPAROSCOPES, ENDOSCOPES, TROCARS, CANNULAS, CUTTERS, CLAMPS, ELEVATORS, GOUGES, KNIVES, SCOPE PREHEATERS, LIGHT SOURCES, CABLES AND COMPONENT PARTS, ELECTROSURGICAL INSTRUMENTS, ELECTROCAUTERY INSTRUMENTS, LASER INSTRUMENTS, ULTRASOUND INSTRUMENTS, LENS CLEANING, SCRUB AND BIOPSY BRUSHES, CLIP APPLIERS AND CLIPS, TACK APPLIERS AND TACKS, APPLICATORS, LIGATURE CARRIERS, NEEDLE HOLDERS,

CLAMPS, HEMOSTATS, GRASPERS, CURETTES, INSTRUMENT GUIDES, LIGATURE PASSING AND KNOTTING INSTRUMENTS, NEEDLE, RETRACTORS, SNARES, STYLETS, FORCEPS, DISSECTORS, CALIPERS, SCISSORS, SUCTION AND IRRIGATION PROBES, STERILE DRAPES, HEMOSTATS, AMPUTATION HOOKS, OSTETOMES, SAWS, RETAINERS, SUTURING APPARATUS, MEASURING TAPES, CHISELS AND CONTRACTORS, FILES, SKIN GRAFT EXPANDERS, LANCETS, MALLETS, PLIERS, HAMMERS, RASPS, SPATULAS, AND STRIPPERS; A FULL LINE OF FDA CLASSES I AND II EXEMPT SURGICAL INSTRUMENTS, NAMELY, SCALPELS, SCALPEL BLADES AND HANDLES, STAPLERS, TACKERS, CLIP APPLIERS, ELECTROCAUTERY TOOLS FORCEPS, NEEDLE HOLDERS, GUIDES AND DRIVERS, GRASPERS, AND KITENERS, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 7-7-2000; IN COMMERCE 7-7-2000.

SN 75-982,190, FILED 3-19-1999.

VERNA BETH RIRIE, EXAMINING ATTORNEY

EXHIBIT B

FILING RECEIPT FOR TRADEMARK APPLICATION

Page 01 of 02

Sep 19, 2006

This acknowledges receipt on the FILING DATE of the application for registration for the mark identified below. The FILING DATE is contingent upon all minimum filing date requirements being met. Your application will be considered in the order in which it was received. Please review the status of your application every six months from the filing date of your application. You can check the status of your application on-line at <http://tarr.uspto.gov/> or by contacting the Trademark Assistance Center at 1-800-786-9199. Also, documents in the electronic file for pending applications can be viewed and downloaded at <http://www.uspto.gov/>.

MICHELLE D. KAHN
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
FOUR EMBARCADERO CENTER
SEVENTEENTH FLOOR
SAN FRANCISCO, CA 94111

ATTORNEY
REFERENCE NUMBER
038T-126360

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days. Such requests may be submitted by mail to: COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VIRGINIA 22313-1451; by fax to 571-273-9913; or by e-mail to tmfiling_receipt@uspto.gov. The USPTO will review the request and make corrections when appropriate.

SERIAL NUMBER: 76/665748
FILING DATE: Sep 8, 2006
REGISTER: Principal
MARK: DA VINCI S HD SURGICAL SYSTEM
MARK TYPE(S): Trademark
DRAWING TYPE: Words, letters, or numbers and design
FILING BASIS: Sect. 1(b) (Intent to Use)

ATTORNEY: Michelle D. Kahn

OWNER: Intuitive Surgical, Inc. (DELAWARE, Corporation)
950 Kifer Road
Sunnyvale, CALIFORNIA 94086

FOR: Computerized surgical manipulation system comprised of surgeon's console, master control, immersive video display, camera image processing equipment, surgical manipulation system software and instructional manuals provided as a unit, patient-side cart with set-up arms and manipulator slave arms, sterile adaptors to connect arms to instruments, and a full line of reusable, in other words, limited re-use tools, namely, laparoscopes, endoscopes, trocars, cannulas, cutters, clamps, elevators, gouges, knives, scope preheaters, light sources, cables and component parts, electrosurgical instruments, electrocautery instruments, laser instruments, ultrasound instruments, lens cleaning, scrub and biopsy brushes, clip appliers and clips, tack appliers and tacks, applicators, ligature carriers, needle holders, clamps, hemostats, graspers, curettes, instrument guides, ligature passing and knotting instruments, needles, retractors, snares, stylets, forceps, dissectors, calipers, scissors, suction and irrigation probes, sterile drapes, hemostats, amputation hooks, osteotomes, saws, retainers, suturing apparatus, measuring tapes, chisels and contractors, files, skin graft expanders, lancets, mallets, pliers, hammers, rasps, spatulas, and strippers; surgical instruments, namely, scalpels, scalpel blades and handles, staplers, tackers, clip appliers, electrocautery tools, forceps, needle holders, guides and drivers, graspers, and kiteners
INT. CLASS: 010

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

OTHER DATA

OWNER OF U.S. REG. NOS.: 2628871

Design Search Codes:

26.13.21 - Quadrilaterals that are completely or partially shaded